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PATENT LEGAL STAFF  
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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 10

Application Number: 09/607,140  
Filing Date: June 29, 2000  
Appellant(s): ALFVIN ET AL.

**MAILED**

DEC 16 2003

Frank Pincelli, Reg. No. 27,370  
For Appellant

**GROUP 3600**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 22, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the claims as listed are not separately patentable.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5,893,037	Reele et al	4-1999
6,385,595 B1	Kolling et al	5-2002
5,974,401	Enomoto et al	10-1999
6,014,641	Loeb et al	1-2000

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-16 rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 3.

**(11) Response to Argument**

**1. Whether claims 1, 2 and 8-14 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Reelee et al. in view of Kolling et al.**

With reference to claims 1, 2 and 8-14, the Appellant argues that Reelee et al. does not teach the sending of images to a service provider and that images would be sent to a image service provider for storage. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

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(i.e. sending of images to a service provider, a image service provider and images captured by the customer) are not recited in the rejected claim(s). Also the limitation of “images supplied by the owner of the combined image captured telecommunication device” is not recited in the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is Reeley discloses the feature of “visual representation of said captured images” captured by a customer. (See Reeley Column 5 lines 11-18) The images captured by the customer-operator are inherent in the disclosures of Reeley. Reeley does not disclose providing a periodic statement. Kolling discloses the step of providing periodic statement for telecommunication services along with custom enclosures. (See Kolling Abstract, Column 9 line 53 – Column 10 line 9, Column 18 lines 64-65, Column 19 lines 9-15 and lines 43-45) The custom enclosures include visual representation of captured images.

In response to applicant's argument that Kolling is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Reeley teaches a method and system respectively of managing digital images captured by a customer using a combined portable telecommunications and digital image capture device, said method comprising: a telecommunication service provider providing a telecommunication service to a customer (See Reeley Column 1 lines 56-59) and providing a data base for receiving and storing said digital images from said customer using said combined telecommunications device to transmit said

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digital images to said service provider (See Reele Column 5 lines 25-43). It is unrealistic to expect a telecommunication service provider to provide such services for free in the long run. Hence billing the customer for the services provided is natural progression of the disclosure of Reele. Kolling addresses this problem of providing billing and periodic statements to the customer. Hence the two references are analogous.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case there are two transactions for the user, namely receiving visual representation of captured images and receiving a periodic statement or invoice for the service provided. In this case the motivation to combine would be that the users would have benefited from the time saved in managing both the transactions at the same time. The motivation to combine is old and well known. For instance when a customer captures photos on film and sends it in for processing, he or she gets images of the captured images along with a statement indicating the amount to be paid or a receipt if prepaid. Furthermore the customer can select the images he or she wants to be further processed or printed when returning the invoice with the payment. Hence the motivation to combine the transaction is old and well known to one with ordinary skill in the art. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

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See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**2. Whether claims 3 and 7 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Reelee et al. in view of Kolling et al. and further in view of Enomoto et al.**

With reference to claims 3 and 7, the Appellant argues that three references are non-analogous art. The reasons for combining Reelee and Kolling are already addressed above. In response to applicant's argument that Enomoto is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, ordering photo finishing of captured images is a natural progression of the problem posed by the combined disclosures of Reelee and Kolling. Enomoto is also concerned with the same problem. Hence Enomoto is analogous art. The motivation to combine is old and well known. For instance when a customer captures photos on film and sends it in for processing, he or she gets images of the captured images along with a statement indicating the amount to be paid or a receipt if prepaid. Furthermore the customer can select the images he or she wants to be further processed or printed when returning the invoice with the payment. Hence the motivation to combine the transaction is old and well known to one with ordinary skill in the art. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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**3. Whether claims 4-6 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Reeley et al. in view of Kolling et al., and in view of Enomoto et al. and further in view of Loeb et al.**

With reference to claims 3 and 7, the Appellant argues it is not obvious to combine ordering of image goods and/or services payment of telecommunication services. Kolling teaches the step of providing one combined billing for multiple products or services. (See Kolling Figure 12) If a telecommunication services provider provides multiple products or services it would make sense to combine the transactions together so as to achieve integrated record keeping and providing the customer the convenience of paying one bill instead of paying separate bills. It is common for film developers/processors to routinely send statements and solicit orders at the same time. Hence if a telecommunication services provider provides image management and telecommunication services it would have been obvious with one with ordinary skill in the art to combine these features.

**4. Whether claims 15 and 16 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Kolling et al., and in view of Loeb et al.**

With reference to claims 15 and 16, the Appellant argues that Loeb et al. is not directed to storing images on behalf of a customer. It is noted that the feature upon which applicant relies (i.e storing images on behalf of a customer) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Kolling teaches the steps of the steps of a service provider forwarding a periodic statement for services provided to said customer for a predetermined time period (See Kolling Column 9 lines



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6-8) and providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement (See Kolling Figure 12, Column 9 line 53 – Column 10 line 9, Column 18 line 64-65, Column 19 lines 9-15 and lines 43-45). The services include all the services provided by the service provider and the enclosures are interpreted to include a visual representation of said captured images and an order form. Hence if the service provider is a telecommunication services provider providing image management and telecommunication services it would have been obvious with one with ordinary skill in the art to combine these features. Loeb teaches the step of ordering using paper forms (See Loeb Column 4 lines 32-36). Separating the different portions of the statement and the order form makes the presentation of the statement clear and easy to understand. Using perforations to separate portions of an invoice and/or and order form are old and well known in the art. Perforations help the user easily separate different portions of a statement or form and mail the ones that are relevant to that user. The combination of the disclosures taken as a whole suggests that users would benefit from being able to easily separate the invoice and the order form from the rest of the document and mail them together thereby also saving mailing expenses. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Examiner  
Art Unit 3624

November 28, 2003

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